

Docket No. F-9125

Scr. No. 10/582,766

REMARKS

Claims 1-9 remain pending in this application. Claims 1, 2 and 5-7 are rejected. Claims 8 and 9 are restricted by the Examiner based upon original presentation. Claim 3 and 4 are withdrawn by the Examiner.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1 and 2 are rejected as obvious over the Ramsey ('188) reference in view of the Kanamori ('020) reference under 35 U.S.C. §103(a). The applicant herein respectfully traverses these rejections. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is submitted that neither the Ramsey nor Kanamori reference teach the feature that the change payer is provided in the one main body case of the oil supplier apparatus. In the Office Action the Examiner apparently cites the Ramsey reference at col. 3, lines 12-61, for such a teaching. However, a review of the Ramsey reference reveals that the change payer is separately located from the oil supply apparatus shown at 35 in Fig. 3. The customer engaging console 25 houses the automated vending machine for dispensing currency and change. Figs. 4 and 6 show the currency and cash dispensers as 49 and 47, apart from the pump

Docket No. F-9125

Ser. No. 10/582,766

apparatus 35. In Fig. 6 these dispensers are shown in a casing which is clearly separate from the one main body casing of the oil supply apparatus. The dispensers are shown along with the customer interface controller 39 for controlling the associated cash dispenser, and the combination is thus clearly shown within the housing of the customer engaging console 25, and not the pump housing 35.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference(s) for the reasons stated above. Reconsideration of the rejections of claims 1 and 2 and their dependent claims and their allowance are respectfully requested.

Claim 1 also requires that the change payer be operable for carrying out the disbursement process and .. "to make a shift to an idling state ... after lapse of a certain time where no change is needed." With regard to this feature of claim 1, the Examiner contends that it would be obvious for a time delay to exist between the return of the nozzle and the disbursement of change. The Examiner does not address that the claim requires that the change payer enter an idling state when the certain time passes and no change is needed. As such, it is submitted that the subject matter of the claims is not entirely considered.

The certain time lapse which places the change payer into the idle state is not disclosed in the Kanamori reference and there is no indication that a waiting period of the "certain time" lapse would serve any purpose. In the present

Docket No. F-9125

Ser. No. 10/582,766

invention, the change payer enters an idle state in the event a change disbursement signal is not received by the change payer and a certain time lapses. The portions of the references the Examiner appears to rely on are the Ramsey reference at col. 12, lines 39-48, and the Kanamori reference at col. 4, lines 1-27. However, only text portions are cited and it is not explained how these portions teach the claimed subject matter. Hence, it is submitted that the Examiner has not provided sufficient reason for a waiting period of a certain time to be executed prior to returning the change payer to the idling state.

It is also submitted that the claimed "certain time" lapse and idling operation is not inherent in the references. Since the features of the above referenced claims are not specifically recited, the reference must be sufficient to support an inherent disclosure of the subject matter. In *In re Rijckaert*, 28 USPQ2d 1955 (CAFC 1993) the Examiner merely assumed various features were in the reference and relied upon inherency to provide a teaching of the various features of a rejected claim which were not explicitly stated or implied in the reference.

The Court of Appeals of the Federal Circuit stated that:

"The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient [to establish inherency.]" *In re Oelrich*, 666 F.2d 578# 581-82, 212 USPQ 323, 326 (CCPA 1981) (citations omitted) (emphasis added). "That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion

Docket No. F-9125

Ser. No. 10/582,766

supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). *In re Rijckaert*, 28 USPQ2d 1955, 1958 (CAFC 1993). The court concluded that the Examiner had failed to even state a *prima facie* case of obviousness because of the unfounded assumptions of the Examiner and therefore indicated that the applicant need not have rebutted the rejection with arguments against a finding of obviousness.

It would appear that one skilled in the art would practice the inventions of the applied references by simply having a change payer responsive to control signals when they arrive. It is not explained how the applied references suggest the "certain time" lapse leading to the idling state recited in claim 1 and therefore it is respectfully submitted that claim 1 is nonobvious based on this feature because the feature is not disclosed by the references and is not inherent in the references.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference(s) for the reasons stated above. Reconsideration of the rejections of claims 1 and 2 and claims dependent therefrom and their allowance are respectfully requested.

The remaining rejected claims 5-7 are variously rejected over the above references in view of the Cull and Spelter references. It is respectfully submitted that the proffered combination of references cannot render the rejected claims obvious because the secondary Cull and Spelter references do not provide the

RECEIVED
CENTRAL FAX CENTER

JUL 06 2009

Docket No. F-9125

Ser. No. 10/582,766

teachings noted above with respect to the obviousness rejections of claims 1 and 2 that are absent from the primary Ramsey reference and secondary Kanamori reference. Thus, the combination of prior art references fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejections of claims 5-7 and their allowance are respectfully requested.

REQUEST FOR EXTENSION OF TIME

Applicant respectfully requests a one month extension of time for responding to the Office Action. Please charge the fee of \$130.00 for the extension of time to Deposit Account No. 10-1250.

If there is any discrepancy between the fee(s) due and the fee payment authorized, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Docket No. F-9125

Ser. No. 10/582,766

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants
[Signature]
and,

By Herbert F. Ruschmann
Herbert F. Ruschmann
Reg. No. 35,341
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340